

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Stephen Mark MUELLER et al. Group Art Unit : 2155
Appl. No. : 10/628,248 Examiner : B. R. Bruckart
Filed : July 29, 2003 Confirmation No. : 5445
For : PRESENCE ENHANCED TELEPHONY SERVICE
ARCHITECTURE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir :

In response to the Final Official Action of July 26, 2007, and concurrently with the filing of a Notice of Appeal, Applicants respectfully request a pre-appeal brief panel to review and withdraw the outstanding rejections. Further, Applicants request an indication of the allowability of all claims pending in the present application in view of the herein contained remarks.

While no fees are believed necessary to ensure consideration of the instant Request, should any fees be deemed necessary, the undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

Applicants respectfully traverse each of the Examiner's four separate grounds of rejection presented in the Final Office Action, since a *prima facie* case of unpatentability has not been shown for any one of the rejections. Applicants submit the following, as examples of clear legal and factual deficiencies in the outstanding rejection:

A. The rejection of claims 1-4, 6, 10-11, 13-14, 16-17 and 20-22 under 35 U.S.C. §102(e) based on PESSI et al. is clearly erroneous

The rejection of claims 1-4, 6, 10-11, 13-14, 16-17 and 20-22¹ under 35 U.S.C. § 102(e) based PESSI et al. (US 2004/0083291 A1) is clearly erroneous. In this regard, PESSI et al. do not disclose each and every element of independent claims 1, 10, 13, or 16. For example, PESSI et al. do not disclose, *inter alia*, comparing a session initiator's identity to preferences of a session terminator (or target), and sending a preferred treatment to a requestor and initiating a session based on the preferred treatment, as required for a *prima facie* rejection based on anticipation of, *e.g.*, independent claims 1, 10 or 13. Furthermore, PESSI et al. do not disclose, *inter alia*, generating a request for presence information in response to a received session request from a session initiator, receiving preferred treatment from a presence platform and initiating a telecommunications session with another user in response to the obtained presence information and the preferred treatment information, as required for a *prima facie* rejection based on anticipation of, *e.g.*, independent claim 16.

PESSI et al. disclose a system and method for conveying terminal capability and user preferences-dependent content characteristics for content adaptation. PESSI et al. provide for communication between diverse terminal devices that may be incompatible with each other. While PESSI et al. disclose a number of embodiments for providing communication between terminals that may be incompatible with each other, the embodiments address the problem of incompatibility between the devices in at least one of two ways, *i.e.*, by using a proxy server to adapt a message from the source terminal device to a format compatible with a destination (target) terminal device and/or by storing the message at the proxy server and forwarding only a link to the destination terminal device. Applicants note that only two of the embodiments, *i.e.*, FIG. 3 and FIG. 6, appear to include a Presence Server. However, PESSI et al. do not disclose comparing a session initiator's identity to preferences of a session terminator (or target), and sending a preferred treatment to a requestor and initiating a session based on the preferred treatment, as required for a *prima facie* rejection based on anticipation of, *e.g.*, independent claims 1, 10 or 13. Furthermore, PESSI et al. do not disclose generating a request for presence information in response to a received session request from a session initiator, receiving preferred treatment from a presence platform and initiating a telecommunications session with another user

¹ Applicants note that the term "22" appears to be a typographical error as claim 21 is the highest-numbered claim presently pending in the above-captioned application.

in response to the obtained presence information and the preferred treatment information, as recited, *e.g.*, in independent claim 16.

The rejection of, *e.g.*, independent claims 1, 10, 13 and 16 primarily relies on paragraphs [0034], [0035], [0037], [0041], [0046], [0049] and [0123], as well as FIG. 4, in PESSI et al. However, as discussed below, PESSI et al. disclose a system that is very different from the invention claimed in, *e.g.*, independent claims 1, 10, 13 or 16.

For example, PESSI et al. disclose that the terminal devices may vary in terminal characteristics, such as, for example, display size and resolution, available memory, or formats that are supported by the terminal devices. *See, e.g.*, page 1, paragraph [0002]. Referring to, for example, FIG. 1 through FIG. 6, as well as paragraphs [0041] through [0061], PESSI et al. disclose a desktop computer 106 (in FIG. 1) sending a message (*e.g.*, 216 in FIG. 2; 312 in FIG. 3; 408 in FIG. 4; 506 in FIG. 5; or 601 in FIG. 6) to a destination (target) wireless terminal 116B (in FIG. 1), where the message, in traveling from computer 106 to the destination terminal 116B, is routed through an appropriate network element 124 (in FIG. 1) that has access to a CPI 122 for the destination terminal 116B. The CPI 122 includes information regarding the capabilities and preferences for the wireless terminal 116B. The network element 124, using the CPI 122 associated with the destination terminal 116B, adapts the content of the message (*e.g.*, 218 in FIG. 2; 318 in FIG. 3; 416 in FIG. 4; 514 in FIG. 5; or 604, 612, 618, 624, 630 and 636 in FIG. 6) received from the computer 106 into a format adapted to the preferences and/or terminal capabilities of the destination terminal 116B, before forwarding the adapted message to the destination terminal 116B. The adapted message is forwarded to the destination terminal 116B, by the network element 124, on the basis of, for example, a contact address for the destination terminal 116B that has been registered in a SIP registrar 204 by the destination terminal 116B. As discussed, for example, at page 4, paragraph [0043], the destination terminal 116B, upon initialization, sends a REGISTER message 206, which includes a SIP uniform resource identifier (URI), which is used by the SIP register 204 to “bind,” or associate the user’s SIP URI with the terminal the user is currently using, *i.e.*, the destination terminal 116B.

PESSI et al. do not disclose comparing a session initiator’s identity to preferences of a session terminator (or target), and sending a preferred treatment to a requestor and initiating a session based on the preferred treatment, as required for a *prima facie* rejection based on anticipation of, *e.g.*, independent claims 1, 10 or 13. Furthermore, PESSI et al. do not disclose generating a request for presence information in response to a received session request from a

session initiator, receiving preferred treatment from a presence platform and initiating a telecommunications session with another user in response to the obtained presence information and the preferred treatment information, as recited, *e.g.*, in independent claim 16.

Thus, because PESSI et al. do not disclose each and every element of, *e.g.*, independent claims 1, 10, 13 or 16, the rejection of independent claims 1, 10, 13 and 16 under 35 U.S.C. § 102(e) based on PESSI et al. is clearly erroneous and should, therefore, be reconsidered and withdrawn.

Claims 2-4, 6, 11, 14, 17 and 20-21, not discussed herein, depend from an allowable base claims and are allowable by virtue of the allowability of their respective base claims.

B. The three separate rejections under 35 U.S.C. §103(a) are clearly erroneous

Applicants respectfully traverse each of the following rejections as being clearly erroneous, including: (1) the rejections of claims 5, 7 and 9 under 35 U.S.C. § 103(a) based on PESSI et al. and LILLIE et al. (US 2004/0131042 A1); (2) the rejection of claims 12, 15 and 19 under 35 U.S.C. § 103(a) as being unpatentable over PESSI et al. in view of LEI et al. (US 2004/0203664 A1); and (3) the rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over PESSI et al. in view of HIRI et al. (US 7,123,707 B1). In this regard, any proper combination of PESSI et al. with any one or more of LILLIE et al., LEI et al. and/or HIRI et al. does not disclose or render obvious each and every element of independent claims 1, 10, 13 or 16. For example, any proper combination of PESSI et al., LILLIE et al., LEI et al. or HIRI does not disclose or render obvious, *inter alia*, comparing a session initiator's identity to preferences of a session terminator (or target), and sending a preferred treatment to a requestor and initiating a session based on the preferred treatment, as required for a *prima facie* rejection based on obviousness of, *e.g.*, independent claims 1, 10 or 13, or generating a request for presence information in response to a received session request from a session initiator, receiving preferred treatment from a presence platform and initiating a telecommunications session with another user in response to the obtained presence information and the preferred treatment information, as required for a *prima facie* rejection based on obviousness of, *e.g.*, independent claim 16.

The above-noted three rejections under 35 U.S.C. § 103(a) concede that PESSI et al.: (1) fail to state an INVITE message (*see, e.g.*, page 7 of the final Official Action); (2) fail to teach notifying a calling party (*see, e.g.*, page 8 of the final Official Action); and (3) fail to teach

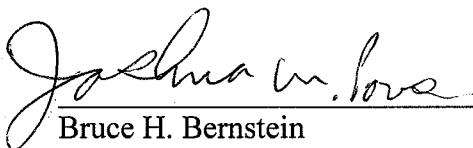
voicemail (*see, e.g.*, page 9 of the final Official Action). The rejections, therefore, rely on: (1) LILLIE et al. only to teach a session initiator initiating a session by sending an INVITE message to a session terminator in order to establish a connection between the points; (2) LEI et al. only to teach an intelligent peripheral that informs an agent of a calling party when a called party rejects a request for a session (instead asking the calling party whether the calling party wishes to leave a message, *see, e.g.*, page 8 of the final Official Action and paragraph [0047] in LEI et al.); and (3) HIRI et al. only to teach a voicemail functionality (*see, e.g.*, page 9 of the final Official Action). Applicants submit, however, that none of LILLIE et al., LEI et al. and/or HIRI et al. compensate for the above-noted deficiencies found in PESSI et al. That is, none of LILLIE et al., LEI et al. and/or HIRI et al., whether taken alone or in any proper combination, disclose or render obvious, *inter alia*, comparing a session initiator's identity to preferences of a session terminator (or target), and sending a preferred treatment to a requestor and initiating a session based on the preferred treatment, as set forth, *e.g.*, in independent claims 1, 10 or 13, or generating a request for presence information in response to a received session request from a session initiator, receiving preferred treatment from a presence platform and initiating a telecommunications session with another user in response to the obtained presence information and the preferred treatment information, as set forth, *e.g.*, in independent claim 16.

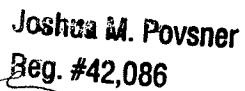
Thus, because any proper combination of PESSI et al., LILLIE et al., LEI et al. and/or HIRI et al. does not disclose or render obvious each and every element of, *e.g.*, independent claims 1, 10, 13 or 16, the rejections of claims 5, 7, 9, 12, 15, 18 and 19 under 35 U.S.C. § 103(a) based on PESSI et al. in combination with any of LILLIE et al., LEI et al. or HIRI et al. is erroneous, since claims 5, 7, 9, 12, 15, 18 and 19 depend from claims 1, 10, 13 or 16, and are patentably distinguishable for at least the reasons provided above with respect to claims 1, 10, 13 and 16, as well as for additional reasons related to their own recitations.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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